

Serial No.: 09/594,667
John et al.
Examiner: Roy R. Teller
Filed: June 15, 2000

Remarks

Claims 1, 4, 5, 16, 19, 26, 27, 30, 37, 75, 78, 79, 90, 93, 100, 101, 104 and 111 stand rejected as being obvious in view of U.S. Patent No. 4,636,491 (Bock et al.). In rejecting the claims, the Examiner merely argues that the "invention is drawn to statine derived tetrapeptide inhibitors of the beta secretase enzyme" and notes that "Bock teaches renin inhibitory tetrapeptides and analogs thereof." Office Action, page 3. The Examiner then concludes that "[f]rom the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention." Action, page 3. The Action contains no further analysis of the structures disclosed in the Bock et al. patent or required by the pending claims. Applicants note that some examples of Bock et al. contain a statine residue.

The claims are directed to compounds containing an amino acid residue having a backbone chain of the type in statine, i.e., a 4-amino-3-hydroxybutanoic acid residue that is substituted at the 4-position of the butanoic acid with R₂. Statine is an amino acid that can be named as (3S,4S)-4-amino-3-hydroxy-6-methylheptanoic acid. As noted above, Bock et al. discloses some compounds containing statine residues. However,

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the claimed compounds contain additional structural requirements that are not found in Bock et al. and are not suggested by that reference. See, e.g., pending claim 1. Thus, there are significant differences between the claims and the prior art. There is nothing in the Action discussing these differences or why they would be obvious. These differences would not have been obvious to one of ordinary skill in the art. Thus, the claims are clearly patentable in view of Bock et al. Applicants respectfully request the Examiner to reconsider and withdraw the rejection based on Bock et al.

The claims also stand rejected for obviousness-type double patenting in view of U.S. Patent No. 6,627,739 (Anderson et al.). The Examiner states that the subject matter of the claims is fully disclosed in Anderson et al. and "is covered by the patent since the patent and the application are claiming common subject matter, as follows: beta secretase enzyme compositions." Action, page 4.

Before discussing the Anderson et al. reference, Applicants wish to make clear that the pending claims relate to compounds and pharmaceutical compositions, not to "beta secretase enzyme compositions."

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Anderson et al. relates to and discloses "various forms of an active, isolated β -secretase enzyme in purified and recombinant form." Anderson et al., Abstract. This patent says it pertains to "inhibitors of this enzyme, which are considered candidates for therapeutics in the treatment of amyloidogenic diseases such as Alzheimer's disease" and "screening methods, assays, and kits for discovering such therapeutic inhibitors, as well as diagnostic methods for determining whether an individual carries a mutant form of the enzyme." Anderson et al., column 1, lines 8-23.

There is nothing in either the claims (which should be the focus of an obviousness-type double patenting analysis) or specification of Anderson et al. that suggests the compounds of the instant claims. Claim 1 of Anderson et al. is directed to an antibody. The Anderson et al. specification discloses a handful of compounds that allegedly function as inhibitors of the β -secretase enzyme. None of those compounds suggest the compounds of the claims. Even if they did, the fact that they are not claimed in Anderson et al. precludes a conclusion that the compounds of this application are unpatentable under the doctrine of obviousness-type double patenting. The claims are clearly patentable in view of Anderson et al. Applicants

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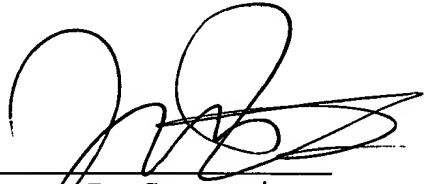
respectfully request the Examiner to reconsider and withdraw the rejection based on Anderson et al.

Allowance of the claims and passage of the case to issue are respectfully solicited. Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,

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